

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FRANCIS GABRIEL and DAVID MEERMANS

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Appeal No. 1999-1991  
Application No. 08/611,725<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge, NASE and  
BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1, 3 to 10 and 12 to 23, as amended subsequent to the final rejection. These claims constitute all of the claims pending in this application.

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<sup>1</sup> Application for patent filed March 6, 1996.

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We REVERSE.

BACKGROUND

The appellants' invention relates to a fan blade applique. An understanding of the invention can be derived from a reading of exemplary claims 1, 10 and 17 (the independent claims on appeal), which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Reese 1962	3,067,054	Dec. 4,
Meulenberg 1982	4,333,781	June 8,
Carnahan 1994	5,370,721	Dec. 6,
Conklin, Jr. (Conklin) 28, 1995	5,470,205	Nov. 28,

Claims 1, 3, 4, 7 to 10, 14 to 17 and 20 to 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Conklin in view of Carnahan.

Claims 5, 12 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Conklin in view of Carnahan as

applied to claims 1, 10, and 17, respectively above, and further in view of Reese.

Claims 6, 13 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Conklin in view of Carnahan as applied to claims 1, 10, and 17, respectively above, and further in view of Meulenberg.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 8, mailed December 2, 1997) and the answer (Paper No. 18, mailed September 28, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 17, filed July 27, 1998) and reply brief (Paper No. 19, filed December 7, 1998) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and

claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 3 to 10 and 12 to 23 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The scope and content of the applied prior art are set forth on pages 8-10 of the final rejection. After determining the scope and content of the prior art, the examiner ascertained that Conklin's applique lacks the claimed pressure sensitive adhesive material coated thereon.

With regard to this difference, the examiner determined (final rejection, pp. 8-9) that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to attach the applique 32 of Conklin to the blades by means of pressure sensitive adhesive material coated thereon such that the applique is removable from the fan without causing damage to the blade surface as taught by Carnahan.

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims on appeal include an applique made of flexible material having a rear surface coated with a pressure sensitive adhesive material which permits the applique to be

applied to and removed from a ceiling fan blade. However, these limitations are not suggested by the applied prior art. In that regard, while Carnahan does teach a layer of adhesive 50 attached to the lower surface 30 of filter 14 for attaching the filter to a fan blade, it is our opinion that Carnahan's teachings would not have suggested modifying Conklin's applique (i.e., decorative sheet 32) to have included a rear surface coated with a pressure sensitive adhesive material which permits the applique to be applied to and removed from a ceiling fan blade.

In our view, the only suggestion for modifying Conklin in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Furthermore, the mere fact that the prior art may be modified in the manner suggested by the examiner

does not make the modification obvious unless the prior art suggested the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It follows that we cannot sustain the examiner's rejections of claims 1, 3 to 10 and 12 to 23.



CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3 to 10 and 12 to 23 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge	)	
)	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

Appeal No. 1999-1991  
Application No. 08/611,725

Page 10

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APPEAL NO. 1999-1991 - JUDGE NASE  
APPLICATION NO. 08/611,725

APJ NASE

APJ BAHR

SAPJ McCANDLISH

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 08 Nov 99

**FINAL TYPED:**